

## **Remarks and Arguments**

Claims 1-2, 9-10,12, and 19-21 are pending in this application. Claims 1, 2, and 19 are amended to more particularly point out the invention. Support for the amendments can be found in Figure 8, and in the specification. Each of the rejections is addressed below.

### **Rejection under 35 U.S.C. § 112**

Claim 21 was rejected as failing to comply with the written description requirement and for further failing to particularly point out and distinctly claim the subject matter which applicants considers as the invention on the basis that there is allegedly no basis in the original disclosure for the limitation that the circumferential struts are perpendicular to the longitudinal struts. Applicants respectfully note that page 4 lines 22-25 of the specification as filed provides the required basis. Applicants respectfully traverse this rejection and request reconsideration.

### **Anticipation Under 35 U.S.C. § 102(b)**

#### **1. The Anticipation Standard**

The standard required for finding anticipation under 35 U.S.C. § 102(b) is stated in MPEP § 2131. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.' *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). 'The identical invention must be shown in as complete detail as is contained in the...claim'. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989)."

A prior art reference must contain an enabling disclosure. MPEP 2121.01 states in relevant part: "[i]n determining that quantum of prior art disclosure which is necessary to declare an applicant's invention 'not novel' or 'anticipated' within section 102, the stated test is whether a reference contains an 'enabling disclosure'... ." *In re Hoeksema*, 399 F.2d 269, 158 USPQ 596 (CCPA 1968). The disclosure in an assertedly anticipating reference must provide an enabling disclosure of the desired subject

matter; mere naming or description of the subject matter is insufficient, if it cannot be produced without undue experimentation. *Elan Pharm., Inc. v. Mayo Found. For Med. Educ. & Research*, 346 F.3d 1051, 1054, 68 USPQ2d 1373, 1376 (Fed. Cir. 2003)."

## **2. Claim 1, 9, 10, 12 and 21**

Claims 1, 9, 10, 12 and 21 stand rejected under 35 U.S.C. 102(b) as being unpatentable over Pinchasik et al. (U.S. Patent No. 5,449,373). Amended independent claim 1 includes the limitation(s) "wherein some of the circumferential support structures are interconnected to an adjacent circumferential support structure thus forming interconnected pairs of circumferential support structures, said interconnections being formed by a plurality of circumferential connecting struts extending between a plurality but not all of the apex portions of the interconnected pairs of circumferential support structures". Applicant(s) respectfully submit that these limitation(s) are not taught in Pinchasik. Rather, Pinchasik teaches that all apex portions between interconnected circumferential support structures should be interconnected, see e.g., Figs. 2a-2b.

Further, amended claim 1 includes "each circumferential support structure is directly connected to an adjacent circumferential support structure at a plurality but not all apex portions". Pinchasik, however, teaches that all directly connected circumferential support structures are directly connected at each apex (see e.g., Figs. 2a and 2b)

Thus, Applicants respectfully submit that claim 1 and all claims depending therefrom are novel and non-obvious over Pinchasik for at least these reason.

## **Obviousness Under 35 U.S.C. § 103**

### **1. The Obviousness Standard**

MPEP §2143 provides the standard required to establish a prima facie case of obviousness. "First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in

the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references combined) must teach or suggest all the claim limitations.”

The motivation to make the claimed invention and the reasonable expectation of success must both be found in the prior art, not the applicant’s disclosure. *In re Vaeck*, 947, F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). The references must be considered as a whole and must suggest the desirability, and thus the obviousness of making the combination. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 U.S.P.Q. 182, 187 n.5 (Fed. Cir. 1986); MPEP § 2141. The Patent and Trademark Office (PTO) bears the burden of initially establishing a prima facie case of obviousness. MPEP §2142. The PTO has not met its burden in the instant case.

## **2. Claims 2, 19, and 20**

Claims 2, 19 and 20 stand rejected under 35 U.S.C. 103 as being unpatentable over Pinchasik in view of Wijay (U.S. Patent Number 5,824,059).

The Patent Office states that the invention of claims 2, 19 and 20 would have been obvious because staggering provides the benefit of a more continuous support to the blood vessel around its circumference. Applicant(s) respectfully disagree with this reasoning and conclusion. The degree of coverage or support depends on the thickness of the struts and the stent pore size (i.e., size of holes). Modifying the orientation of the connectors would not result in increased vessel coverage because it would not necessary result in a change of strut thickness or pore size.

In addition, as stated above, claim 1 (from which claim 2 depends) and claim 19 (from which claim 20 depends) require paired interconnected circumferential support structures that are interconnected at a plurality but not all of their apex portions. This is not taught in Pinchasik which teaches interconnection of all apex portions between interconnected structures.

Referring to Figures 3 and 4, Wijay teaches that each circumferential support structure is interconnected to an adjacent circumferential support structure at only one apex portion (i.e., “apex portion” is defined in the instant specification, page 3, line 30,

through page 4 line 1, as the region where two longitudinal struts are joined). It does not teach apex to apex connection. Wijay explains why this alternating pattern of apex to non-apex connections is used: "As a result, crosstie 90, when the stent 58 is expanded, puts a clockwise force on segment 88, while crosstie 94, when the stent 85 is radially expanded, puts a counterclockwise force on segment 86. The net result of the crossties 90 and 94 is to apply a closing force to segments 86 and 88, which make up the longitudinal opening 80, so that there is a greater resistance to growth of the opening 80 than there is to the widening of an individual set of return bends, such as 100. In a similar manner, the longitudinal openings 82 and 84 are impacted by their crossties from above and below" (col. 7 line 2-12). Wijay goes on to state that more than one adjacent ring can be next to another adjacent ring (col. 7, lines 30-35), but does not explain how such a design could achieve the stated goal of applying a closing force to segments. Wijay crossties are critically interconnecting the end struts which form the border of each longitudinal gap, and consequently cannot be relocated to adjacent apex portions without compromising the "counteracting" force needed to prevent the gaps from opening during stent expansion. Such a design would fail to achieve Wijay's stated goal since all such crossties would attach to apex portions at both ends, and hence would not exert a clockwise or counterclockwise force on segments. Wijay therefore not only does not anticipate Applicant(s)' claimed invention but in fact teaches *away* from it.

The inventive stent provides a number of benefits over the prior art, including improved wall coverage, improved flexibility through out the stent, and improved radial strength through out the stent. Neither Wijay nor Pinchasik suggest the modifications necessary to attain these benefits nor do they teach that each of these benefits can be accomplished by the inventive features of claimed invention.

Applicants respectfully request reconsideration and allowance of all rejected claims.

## **RECONSIDERATION**

It is believed that all claims of the present application are now in condition for allowance.


Reconsideration of this application is respectfully requested. If the Examiner believes that a teleconference would expedite prosecution of the present application the Examiner is invited to call the Applicant's undersigned attorney at the Examiner's earliest convenience.

Any amendments or cancellation or submissions with respect to the claims herein is made without prejudice and is not an admission that said canceled or amended or otherwise affected subject matter is not patentable. Applicant reserves the right to pursue canceled or amended subject matter in one or more continuation, divisional or continuation-in-part applications.

To the extent that Applicant has not addressed one or more assertions of the Examiner because the foregoing response is sufficient, this is not an admission by Applicant as to the accuracy of such assertions.

Please grant any extensions of time required to enter this response and charge any fees in addition to fees submitted herewith that may be required to enter/allow this response and any accompanying papers to our deposit account 02-3038 and credit any overpayments thereto.

Respectfully submitted,



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Inna Landsman, Esq. Reg. No. 44,337  
RISSMAN JOBSE HENDRICKS & OLIVERIO, LLP  
Customer Number 021127  
Tel: (617) 367-4600 Fax: (617) 367-4656